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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,741	07/03/2003	John C. S. Koo	31045-101	5633
43914 7590 12/30/2009 JOSEPH SWAN, A PROFESSIONAL CORPORATION 1334 PARKVIEW AVENUE, SUITE 100 MANHATTAN BEACH, CA 90266				
EXAMINER MOHANDESI, JILA M				
ART UNIT 3728		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/613,741

Applicant(s)

KOO, JOHN C. S.

Examiner

JILA M. MOHANDESI

Art Unit

3728

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on APDP 08/28/09.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-8, 21-23, 33 and 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-8, 21-23, 33 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)
- Paper No(s)/Mail Date 09/21/09.
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application.
- 6) ☐ Other: _____.

DETAILED ACTION

1. The Board of Patent Appeals and Interferences (BPAI) rendered its decision on August 28, 2009. The BPAI decision is as follows:
2. The Board affirmed the rejection of independent claims 1 and 30 under 35 U.S.C. § 103(a) as being obvious in view of Shin (US 4,658,514) in view of Root (US 2,793,136). The Board also affirmed the rejection of dependent claims 2-5, 9-20, 24-29, 31, 32, 34, and 36 fall with claims 1 and 30. 37 C.F.R. § 41.37(c)(1)(vii), and dependent claim 9 in view of Shin, Root and Bible (US 4,779,360).
3. The Board reversed the rejections of dependent claims 6-8, 21- 23, 33, and 35 under 35 U.S.C. § 103(a).

There are no allowed claims in this application.

Prosecution for this application has been re-opened and new grounds of rejection follow for claims 6-8, 21-23, 33 and 35. No parts of affirmed claims 1-5, 9-20, 24-32, 34 and 36 are part of this re-opening.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on 09/21/09 was filed after the BPAI decision of 08/28/09. Accordingly, the information disclosure statement is being considered by the examiner.
5. This application is a CIP of US Application 10/438,375, now U.S. Patent No. 7,191,549 and US Application 11/530,419 is a CIP of this US Application, the examiner

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has considered the information provided in the parent and child applications (per MPEP 609.02).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 6 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shin 4,658,514 in view of Root 2,793,136 and Giese, Jr. 2,663,097.

Claims 6 and 35, further add the limitation of using a flocking technique to apply the fabric particles to the shoe. The combination of Shin '514 and Root '136 discloses all the limitations of the claims except for the use of a flocking technique.

Giese, Jr. '097 teaches that particles can be attached to the sole of a shoe by flocking to help gain traction on slippery surfaces. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to flock

the particles onto the bottom sole of the shoe of Shin '514- Root '136 as taught by Giese, Jr. '097 to help hold the particles onto the bottom of the shoe to gain traction.

Furthermore, the determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shin 4,658,514 in view of Root 2,793,136 and Regula 1,499,785.

Claim 7 further defines the small particles to comprise at least one of natural and synthetic leather. The combination of Shin '514 and Root '136 disclose all the limitations of the claims except for the small particle material being made of natural or synthetic leather.

Root '156 discloses that a variety of particles can be used for forming the slip resistant surfaces. Regula '784 discloses that it is desirable to make use of old leather, or scrap leather by chopping it in small particles and use it in soles and heels of shoes for high durability and flexibility. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to make the particles of Shin'514-Root '514 out of leather as taught by Regula '784 for better durability and flexibility, since it has been held to be within the general skill of a worker in the art to

select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shin 4,658,514 in view of Root 2,793,136 and Wentworth 2,103,884.

Claim 8 further defines the small particles to comprise at least one of natural and synthetic rubber. The combination of Shin '514 and Root '136 discloses all the limitations of the claims except for the small particle material being made of natural or synthetic rubber.

Root '156 discloses that a variety of particles can be used for forming the slip resistant surfaces in the article of footwear. Wentworth '884 discloses that it is desirable to use as filler material, powdered or granular material with resilient character such as ground up tire carcass, or other rubber waste in soles of shoes. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to make the particles of Shin'514-Root '136 out of rubber as taught by Wentworth '884 for resilient characteristic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

11. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shin 4,658,514 -Root 2,793,136 and in view of Diller et al. 2,029,361, Pace (US 4,050,168) and Farrington (US 2,144,330).

Claim 21 further calls for the small particles be bonded using a temporary adhesive that allows the particles to wear off during normal outdoor use. Claim 22

further calls for the temporary adhesive that would allow the particles to wear off within no more than 3 days when worn outdoors in an urban environment on a full-time basis. Claim 23 further calls for the temporary adhesive that would allow the particles to wear off within no more than 3 weeks when worn outdoors in an urban environment on a full-time basis.

The combination of Shin '514 and Root '136 discloses that the small particles are bonded to the bottom of the sole using an adhesive. The "temporary adhesive" of claim 21 has no reference point and is met by the adhesive of Shin'514 and Root '136, since the particles of Shin '514 and Root '136 will eventually wear off. Diller '361, Pace '168 and Farrington '330 have been merely introduced as evidence that show that adhesive materials have different degrees of adhesiveness. Diller '361 discloses an article of footwear where small particles are bonded thereon using a temporary adhesive (see column 1, lines 51-55). Pace '168 discloses that it is desirable to use temporary adhesive (pressure sensitive adhesive layer 26) for attaching symbols to the bottom of the sole so that the symbol may be subsequently detached from the sole and a new and different symbol thereafter applied to the bottom of the sole. Farrington '330 discloses the use of a temporary adhesive for attaching a sheet 16 to an insole by a suitable type of latex, which may be applied entirely over one side thereof, so as to provide temporary adhesive contact between the outer margin of the sheet and the inner margin of the insole. Accordingly, when applying the knowledge of the adhesive to the amount of time "days" and "weeks" in claims 22 and 23, it would depend on the amount of time desired for the particles to remain on the shoe, and would have been obvious to one of

ordinary skill in the art to select the adhesiveness of the adhesive to be used to cover a certain time-wear parameter, since the amount of time, "days" or "weeks" are result determined parameters and such would have been well within the expedient and obvious to the ordinary skilled artisan.

12. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shin 4,658,514 in view of Root 2,793,136 and Kester et al. 4,356,643.

Claim 33 further calls for the small particles be bonded to the bottom surface by using a backing sheet material. The combination of Shin '514 and Root '136 disclose all the limitations of the claims except for the use of a backing sheet material.

Kester '643 discloses a plurality of small particles that is bonded (see col. 2, lines 16-19) to at least some of the lower extending portions and indentation portions (see Figure 2); the small particles are bonded to at least some of the lower extending portions and indentation portions using adhesive material (see col. 2, lines 16-19); the small particles comprises a fabric material (18 is made of nylon material, a fabric material, see column 2, lines 6-15); the small particles are bonded to the bottom of the shoe by backing sheet (16). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to bond the small particles to the bottom surface using a backing sheet as taught and suggested by Kester '643 for a more even bonding of the small particles to the bottom surface or a more better control of the bonding process.

Double Patenting

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 6-8, 21-23, 33 and 35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 11/530,419. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed structure of the application may be wholly derived from the claimed subject matter of the copending application. Both applications are directed to a shoe, comprising: an outsole having a bottom surface; and an upper extending above the outsole, wherein the outsole is comprised of: a base material that includes a plurality of indentations and lower-extending portions and a plurality of small particles, wherein the small particles

are bonded to at least some of the indentations and/or the lower-extending portions, and wherein areas of the small particles and the lower-extending portions form at least a portion of the bottom surface of the outsole. Furthermore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to not bond the small particles in the indentations, since it has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involves only routine skill in the art, *In re Karlson*, 136 USPQ 184.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Claims 6-8, 21-23, 33 and 35 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 7,191,549. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed structure of the application may be wholly derived from the claimed subject matter of the Patent '549. Both the instant application and Patent '549 are directed to a shoe, comprising: an outsole having a bottom surface; and an upper extending above the outsole, wherein the outsole is comprised of: a base material that includes a plurality of indentations and lower-extending portions and a plurality of small particles, wherein the small particles are bonded to at least some of the indentations and/or the lower-extending portions, and wherein areas of the small particles and the lower-extending portions form at least a portion of the bottom surface of the outsole. Furthermore, since Patent '549 claims a more specific embodiment than the instant application, once applicant has received a

patent for a species or a more specific embodiment, he is not entitled to a patent for a generic or broader invention, because the more specific "anticipates" the broader. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

Response to Arguments

16. Applicant's arguments with respect to claims 6-8, 21-23, 33 and 35 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are shoes analogous to applicant's instant invention.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JILA M. MOHANDESI whose telephone number is (571)272-4558. The examiner can normally be reached on MONDAY-FRIDAY 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey YU can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mickey Yu/
Supervisory Patent Examiner, Art Unit 3728

/JILA M MOHANDESI/
Primary Examiner, Art Unit 3728

JMM
11/13/09

/DONALD T HAJEC/
Director, Technology Center 3700